

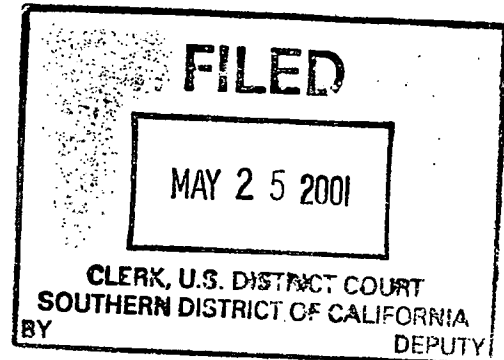
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22 UNITED STATES DISTRICT COURT  
23 SOUTHERN DISTRICT OF CALIFORNIA

24 GEN-PROBE, INCORPORATED,

25 Plaintiff,

26 v.

27 VYSIS, INC.,

28 Defendant.

CASE NO. 99CV 2668H (AJB)

**DECLARATION OF THOMAS W. BANKS IN SUPPORT OF VYSIS' OPPOSITION TO GEN-PROBE'S MOTION FOR PARTIAL SUMMARY JUDGMENT**

Date: June 8, 2001  
Time: 10:30 a.m.  
Dept.: Courtroom 1

I, Thomas W. Banks, declare and state as follows:

1. I have personal knowledge of the facts set forth in this declaration.

2. I am an attorney licensed to practice in the State of California and admitted to

practice in the United States District Court for the Southern District of California. I am a partner at the law firm of Finnegan, Henderson, Farabow, Garrett & Dunner, L.L.P., and represent Defendant Vysis, Inc. ("Vysis") in this litigation.

FILED "99062560"

1           3.       Attached as Exhibit A to this declaration is a true and correct copy of United States  
2 patent application serial number 07/136,920, as filed on December 21, 1987, from the prosecution  
3 history of the '338 patent.

4           4.       Attached as Exhibit B to this declaration is a true and correct copy of the July 20,  
5 1990 Office Action (Paper No. 2) in application serial no. 07/136,920 from the prosecution history  
6 of the '338 patent.

7           5.       Attached as Exhibit C to this declaration is a true and correct copy of the March 12,  
8 1992 Office Action (Paper No. 2) in application serial no. 07/644,967 from the prosecution history  
9 of the '338 patent.

10          6.       Attached as Exhibit D to this declaration is a true and correct copy of the November  
11 5, 1992 Office Action (Paper No. 3) in application serial no. 07/944,505 from the prosecution history  
12 of the '338 patent.

13          7.       Attached as Exhibit E to this declaration is a true and correct copy of the December 5,  
14 1995 Preliminary Amendment and Response to Restriction Requirement (Paper No. 8) in application  
15 serial no. 08/238,080 from the prosecution history of the '338 patent.

16          8.       Attached as Exhibit F to this declaration is a true and correct copy of the October 16,  
17 1997 Notice of Allowability (Paper No. 23) in application serial no. 08/238,080 from the prosecution  
18 history of the '338 patent.

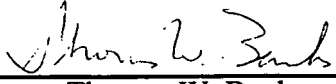
19          9.       Attached as Exhibit G to this declaration is a true and correct copy of the January 16,  
20 2001 Interview Summary (Paper No. 12) in the application for reissue of the '338 patent, serial no.  
21 09/533,906.

22          10.       Attached as Exhibit H to this declaration is a true and correct copy of page 262 of the  
23 transcript of the deposition of Jonathon Michael Lawrie taken February 15, 2001.

24          11.       Attached as Exhibit I to this declaration is a true and correct copy of page 184 of the  
25 transcript of the deposition of James C. Richards taken March 30, 2001.

1  
2 I declare under penalty of perjury under the laws of the United States of America that the  
3 foregoing is true and correct to the best of my knowledge and belief.

4 Executed this 24<sup>th</sup> day of May, 2001 at Palo Alto, California.

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Thomas W. Banks